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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,918	12/31/2003	John F. Mair	MAIR-101	1895

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EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/750,918	MAIR, JOHN F.	
	Examiner	Art Unit	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed June 12, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: *in which the channel is deep enough and wide enough to allow the end of a dowel projecting from a workpiece to move through the channel without restricting movement of the pad after the top of the dowel is cut by the router* (clm. 14).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the originally filed written disclosure nor the drawings provide support for dowel being cut as recited within the claim 14. Additionally, regarding claim 14, "*the bit*" has not been

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positively recited, i.e., there is no antecedent basis for the recitation, “the bit”. As noted above claim 14 appears to contain new matter

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 11, the terms, “*to which the pad may be attached*” are vague and indefinite, i.e., is the pad attached to a router base or not. Further regarding claim 11, the router base has not been positively recited, it is unclear if the combination of the router and offset sub-base is being claimed or if it is just the router sub-base that is being claimed. Clarification is required.

Additionally regarding claim 11, the recitation, “*except the area of the lower surface of the router base forward of the vertical front edge when the pad is so attached*” renders the claim indefinite. Because the router base has not been positively defined and/or recited, it is not clear what is meant by except the area of the lower surface of the router base forward of the vertical front edge.

Regarding claim 16, there is no antecedent basis for “*the router collet*” as such has not been positively recited. Additionally claim 16 appears to be more of a method claim and does not further limit a parent claim

Claims 18-20 are improper dependent claims drawn to a method of cutting a plug having specific process steps. The claims do not further limit a parent claim and in fact change/alter the

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scope of the parent claim(s). For example the parent claims 11-17 are drawn to an apparatus having specifics of structure and elements related to the apparatus, thus the parent claims have a scope encompassing an apparatus and not that of method and apparatus as set forth in dependent claims 18-20. Examiner suggests re-writing claims 18-20 as independent claims including all of the structural limitations of the apparatus claim(s).

All of the claims should be reviewed for clarity, definiteness and antecedent basis concerns.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11, 12, 15 and 18-20 as best as can be understood are rejected under 35

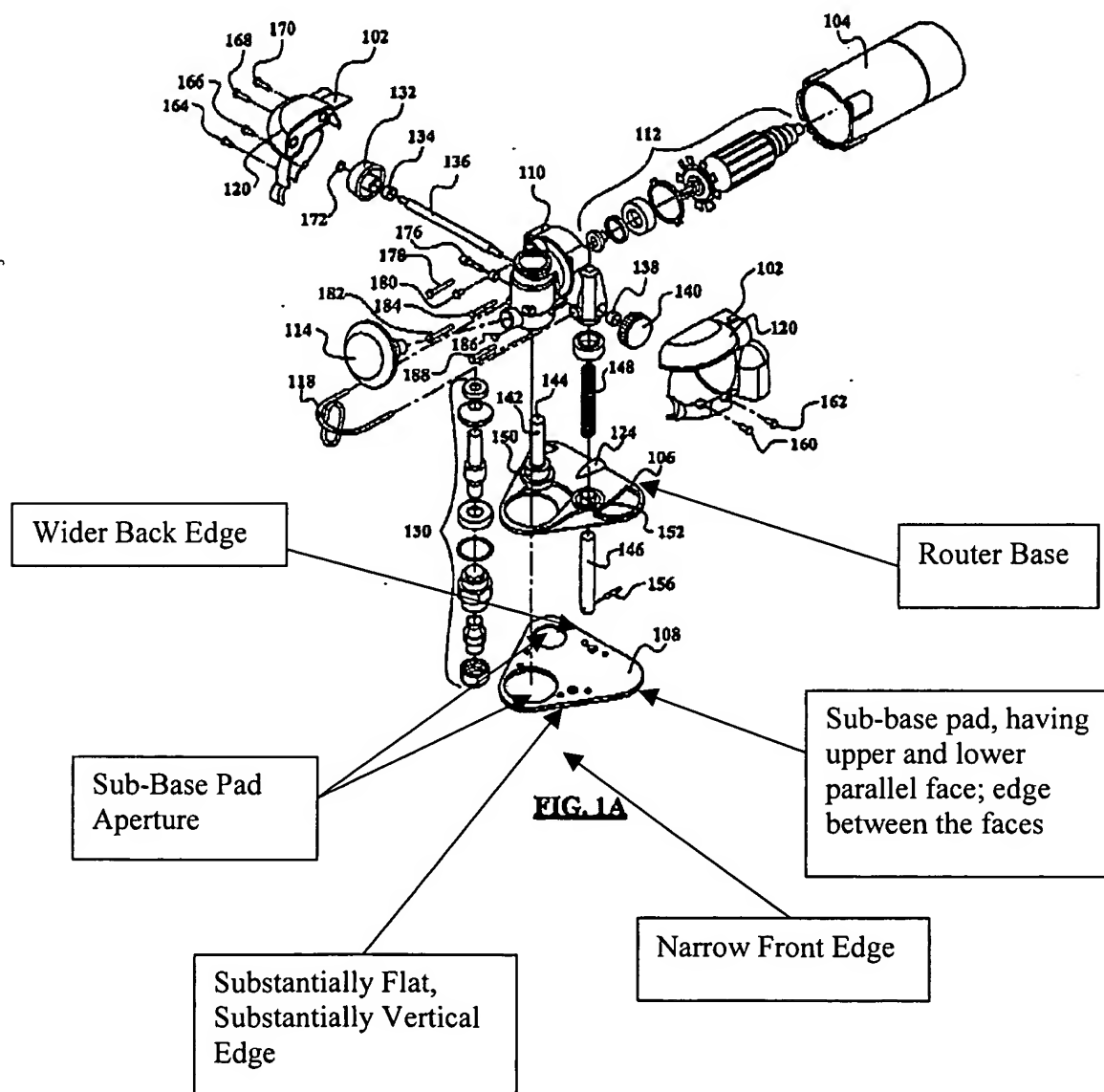
U.S.C. 102(e) as being anticipated by Phillips et al. (6,846,138). Phillips discloses a router sub-base comprising a pad (108) of material having an upper face and a lower face, and substantially vertical front edges, including a substantially vertical front edge and a substantially vertical back edge, the pad upper and lower faces are substantially flat and smooth, the pad upper face is substantially parallel to the pad lower face, the vertical edges are substantially perpendicular to the pad upper and lower faces, the pad is narrower at the front edge than at the back edge, the pad is substantially uniform thickness (fig. 1A), and large enough to cover substantially the

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entire lower surface of a router base to which the pad is attached and means for attaching the pad to the router base (col. 6, lines 36-38) whereby the pad will cover substantially the entire lower surface of a router base .

With regard to claim 12, as best as can be understood, Phillips discloses the front edge of the pad presents a substantially flat, substantially vertical surface toward a router collet.

With regard to claim 15, Phillips discloses the sub-base shaped to extend over substantially the entire lower surface of the base (106).



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As to claims 18-20, Phillips discloses an offset router base attached to a router, a router bit, setting the router on a substantially flat workpiece, powering/turning on the router moving the router across the flat workpiece.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 17 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (6,846,138). With regard to claim 16, Phillips does not disclose the router collet to reside approximately ten one-thousandths of an inch from a flat surface. The specific selection of the distance of the collet/bit from a flat surface requires only routine skill in the art would result from routine engineering practices. Further Examiner notes neither the specification nor the drawings positively recite any criticality to the router collet residing approximately ten one-thousandths of an inch from a flat surface.

With regard to claim 17, Phillips does not disclose the pad is approximately eight tenths of one inch thick. It would have been obvious at the time of the invention to one having ordinary skill in the art to construct Phillips having a pad of eight-tenths thickness because discovering an optimum value of a result effective variable involves only routine skill in the art and in the absence of any positively recited critically does not in itself warrant patentability examiner notes

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the written disclosure is silent to any criticality for the pad having a thickness of eight-tenths inch.

Allowable Subject Matter

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if any 35 U.S.C. 112 rejections were overcome.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest *a channel extending across the lower surface of the sub-base from the vertical front edge to the vertical back edge* in combination with the rest of the claimed limitations as set forth in claim 13.

Response to Arguments

Applicant's arguments filed June 12, 2006 have been fully considered but they are not persuasive. Applicant argues that the prior art of record, Phillips does not disclose, "*the pad is of substantially uniform thickness, and large enough to cover substantially the entire lower surface of a router base to which the pad may be attached, except the area of the lower surface of the router base forward of the vertical front edge when the pad is so attached*". This however is not found persuasive, because the claim as written does not positively recite a router or router base. No structure as it relates to the router or router base has been positively recited within the claims.

Applicant argues that the newly added limitation (underlined portions) corresponds to the area of a router forward of the vertical front edge 18 of Applicant's sub-base and is not found in

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Phillips et al. and Phillips et al., in fact shows a nose extending from the sub-base...the construction of the sub-base in Phillips would not allow a user to move Phillips router and sub-base evenly across the surface of a workpiece in the same way a user may with Applicant's invention." This too is not persuasive. First, Applicant is arguing criticality of structure or structural differences that are not positively recited in the claims. As noted above, no structure of the router has been positively recited within the claims, as such the argument that this corresponds to a router forward of the vertical front edge 18...is not deemed persuasive. Second, claims 11-17 are apparatus claims, and have the ability to so perform or are capable of moving across the surface of a workpiece, as to the argument, "...in the same way a user may with Applicant's invention", no process steps are recited within the apparatus claims 11-17 and thus Applicant's argument is deemed non-persuasive. Accordingly a rejection as best as can be understood is made in view of Phillips et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

August 16, 2006



Lowell A. Larson
Primary Examiner